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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,967	08/05/2003	Michael A. Cook	0103-0021(ZM0538)	8795
43231	7590	10/10/2006	EXAMINER	
ZIMMER TECHNOLOGY - REEVES			WOODALL, NICHOLAS W	
P. O. BOX 708			ART UNIT	
WARSAW, IN 46581-0708			PAPER NUMBER	
			3733	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NI

Office Action Summary

Application No.

10/634,967

Applicant(s)

COOK ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-16, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-16, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 08/18/2006.

Specification

1. The abstract of the disclosure is objected to because it a phrase which can be implied, e.g. "A locking surgical instrument for...". Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology

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often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

4. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 6 contains structural limitations that are not conveyed in the specification (page 9 paragraphs 24 and 25). The specification describes the actuator as a shaft with a first end, a second end, and an axis between them. There is no support in the specification of the actuator having a blunt cylindrical tip as stated in the amended claim 6.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-12, 14-16, and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hajianpour (U.S. 6,286,401).

Hajianpour discloses a screwdriver with a holding feature for socket head

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screws (reference figures 4 and 5 below). Regarding claim 1, Hajianpour shows an instrument with a body (12, 14, 16, and 34) that includes a first end, a second, and an axis between. Hajianpour also shows an engagement tip (16) adjacent to the second end that is receivable by the work piece. The tip (16) is divided by a slit (56) that form segments with the ability to extend outwardly and grip a screw or nail. Regarding claim 3, Hajianpour shows an instrument that has a body with a bore (44 and 46) that extends from the first end of the instrument towards the tip of the instrument and continues a predetermined distance past the beginning of the slits (56). Hajianpour also teaches an actuator (20, 32, 38, 40, 42, and 48) having a shaft (38) that is placed into the bore (44 and 46) of the instrument body (reference figure 4 below). The actuator can be translated axial through the body of the instrument between an unlocked position, in which the actuator is not biasing the tip segments, and a locked position, in which the actuator is biasing the tip segments. Regarding claim 4, Hajianpour shows an actuator that uses threads (32) to engage threads (34) within the body of the instrument (column 4 lines 29-31). Turning the actuator causes it to turn axially between the locked and unlocked positions (column 4 lines 32-34). Regarding claims 5-7, Hajianpour shows that body contains a bore (44 and 46) that contains a tapered section with a larger first diameter and a second smaller diameter. The taper is located past the beginning of the slit (56) located in the tip (16) of the instrument. When the actuator is engaged with the taper, the segments of the instrument tip (16) are expanded outwardly (column 5 lines 3-7). Regarding claim 8, Hajianpour shows an actuator with a tapered end (48) that bias the segments of the instruments tip (16) when engaged with the taper in the bore (44

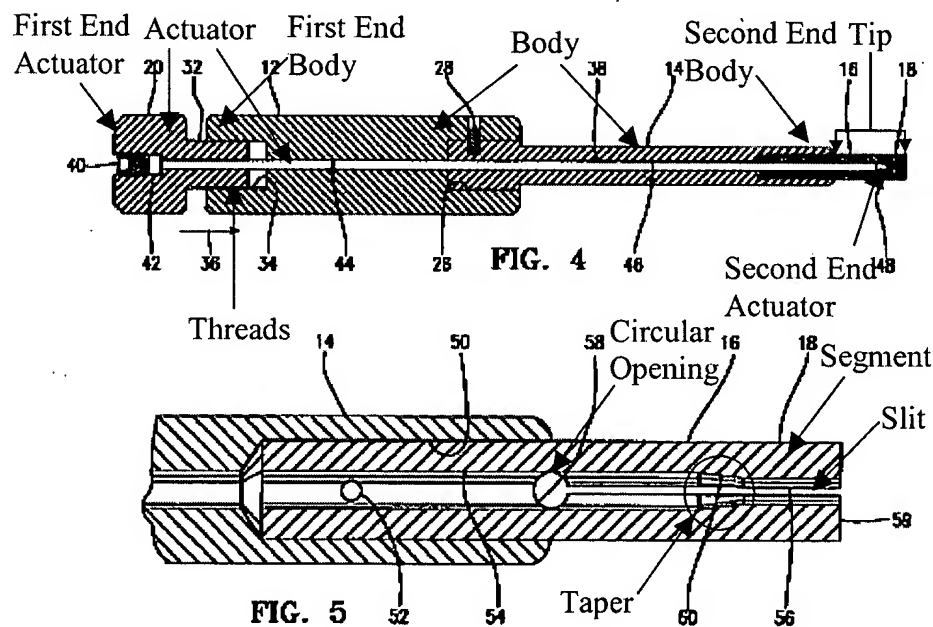
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and 46) of the body. Regarding claim 9, Hajianpour shows the bore (44 and 46) extends completely through the body of the instrument. Regarding claim 10, Hajianpour shows that the slits (56) that through the tip (16) of the instrument terminate with a circular opening (58) to reduce stress concentrations (column 4 lines 51-54). Figure 5 shows the radius of the circular opening (58) to be greater than half the width of the slit (56).

Regarding claim 11, Hajianpour shows an instrument tip (16) that engages a screw or nail in a torque transmitting relationship. Regarding claim 12, Hajianpour shows an instrument tip (16) that has a hexagon shape, reference figure 10 below, which includes flats and vertices to increase the engagement between a screw or nail and the instrument tip (16). Regarding claim 14, Hajianpour disclose that the segments of the instrument tip (16), when biased by the actuator, have at least one vertex that engages the screw or nail. Regarding claim 15 and 16, Hajianpour discloses an instrument that can be used on any screw or pin, including pins or screws used in rotating hinge knee prosthesis, with an internal socket. Regarding claim 20, Hajianpour discloses a device wherein the actuator biases the segments near the segment bases as the actuator is being introduced to the segments. Regarding claim 21, Hajianpour discloses a device wherein the actuator is limited in displacement by the engagement of the second end of the actuator and the first end of the body. With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hajianpour, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require

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that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).



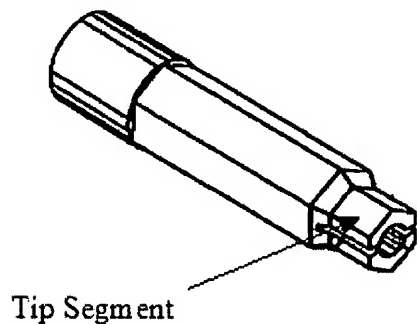


FIG. 10

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hajianpour (U.S. 6,286,401).

Hajianpour discloses the claimed invention except for the engagement tip having a triangular cross-section. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the engagement tip of the device of Hajianpour with a triangular cross-section, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find. In re Dailey and Eilers, 149 USPQ 47 (1966).

Response to Arguments

9. Applicant's arguments filed 08/18/2006 have been fully considered but they are not persuasive.

In response to the applicant's argument that Hajianpour (U.S. 6,286,401) fails to disclose the engagement tip not being slit through the vertices, it is noted in Figure 10 (shown above) Hajianpour discloses an embodiment of the engagement tip wherein the vertices are not intersected by the tip.

In response to the applicant's argument that Hajianpour (U.S. 6,286,401) fails to disclose the engagement tip having a triangular cross-section, it is noted this argument has been addressed above in the 35 U.S.C. 103 rejections section of this office action.

In response to the applicant's argument that Hajianpour (U.S. 6,286,401) fails to disclose the actuator shaft having a having a second end comprising a blunt cylindrical tip, it is noted this argument has been addressed above in the 35 U.S.C. 112 rejections section of the office action.

In response to the applicant's arguments towards newly added claims 20 and 21, it is noted this argument has been addressed above in the 35 U.S.C. 102 rejections section of the office action.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT
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